

REMARKS

Claims 1-20 are all the claims pending in the application. By this Amendment, Applicant editorially amends claim 5 to cure a minor informality. The amendment to claim 5 was made for reasons of precision of language and consistency, and does not narrow the literal scope of the claims and thus does not implicate an estoppel in the application of the doctrine of equivalents. Since the amendment simply cures a minor informality, entry is appropriate.

I. Preliminary Matters

As a preliminary matter, Applicant thanks the Examiner for returning the initialed form PTO/SB/08 submitted with the Information Disclosure Statement filed on January 5, 2007.

II. Summary of the Office Action

Claim 5 is objected because of a minor informality. Claims 13-15 and 20 are rejected under 35 U.S.C. § 102 and claims 1-12 and 16-19 are rejected under 35 U.S.C. § 103(a).

III. Claim Objections

Claim 5 is objected to because of informalities. Applicant respectfully requests the Examiner to withdraw this objection in view of this self-explanatory claim amendment.

IV. Claim Rejections under 35 U.S.C. § 102(b)

Claims 13-15 and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2001/0012051 to Hara et al. (hereinafter “Hara”). Applicant respectfully traverses these grounds of rejection at least in view of the following exemplary comments.

Independent claim 13 recites: “a second portable terminal which receives the first image data, obtains a second image data, combines the first image data and the second image data to

obtain synthesized image data, and displays the synthesized image on a display of the second portable terminal.”

In response to Applicant’s arguments, the Examiner contends that displaying the images side by side (*i.e.*, displaying images at same time) discloses in its “broadest” sense synthesizing or combining images (*see* page 2 of the Office Action). Applicant respectfully disagrees. The Examiner assumes incorrectly that the side-by-side output would inherently require the synthesis of image data.

Hara only discloses displaying the received image and at the same time having a small window for the captured images. That is, in Hara, there is no disclosure or suggestion that the data for the two images are combined or synthesized. The composite image may include both images but the data need not be synthesized. Rather the data can maintain its individual separate character and still be output side by side on the display. In Hara, the image data are strictly kept separate. That is, Hara does not disclose or even remotely suggest combining images into synthesized image data. This is made clear by the fact that if no second image is received, the only image displayed is that of the capturing device. In order for this to occur, the data for the rendering portion of the display must remain discrete, or unsynthesized, from the other image so that the image can be readily dropped.

In summary, the deficiencies of the Hara reference fall to the Examiner’s burden to show inherent inclusion of the claim elements. Therefore, for all the above reasons, independent claim 13 is patentable. Claims 14, 15, and 20 are patentable at least by virtue of their dependency on claim 13.

V. Claim Rejections under 35 U.S.C. § 103

Claims 1-9 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hara, in view of U.S. Patent No. 5,953,050 to Kamata et al. (hereinafter “Kamata”). Applicant respectfully traverses these grounds of rejection at least in view of the following exemplary comments.

Independent claim 1, among a number of unique features, recites: “obtaining first image data by photography.... the portable terminal apparatus combining other image data transmitted by other portable terminal apparatuses with the first image data to obtain synthesized image data; and displaying the synthesized image data.” That is, in an exemplary, non-limiting embodiment of the present invention a photographing image is combined with other photographing image to obtain synthesized image data.

In response to Applicant’s arguments, the Examiner contends that displaying the images side by side (*i.e.*, displaying images at same time) discloses in its “broadest” sense synthesizing or combining images (*see* page 2 of the Office Action). The deficiencies of Hara are set forth above.

Kamata does not cure the above-identified deficiencies of Hara. In Kamata, the images are still kept separate (Fig. 24). Furthermore, Kamata only discloses combining images received from various different locations (Figs. 2 and 4). In Kamata, there is no disclosure or suggestion that the images being combined are the one that is received and another one that is obtained in the device that is doing the combining. In other words, in Kamata, the server (control unit 3 and combiner 4) combines images received from various locations and not the terminals 1. Furthermore, in Kamata, the server only combines received images *i.e.*, the server does not capture or obtain images.

Furthermore, it was previously argued that the proposed combination changes the principle operation of Hara and defeats the purpose of Hara reference. In response to these arguments, the Examiner simply alleges that the secondary reference is not bodily incorporated into the structure of the primary reference (*see* pages 3 to 4 of the Office Action).

However, bodily incorporation was not alleged. The combination of Hara and Kamata would necessarily result in streaming video data to provide video conferencing *i.e.*, the reason for combining data from various locations is to provide an improved video conferencing. Kamata does not disclose or even remotely suggest combining photography images.

This proposed modification would change the principle operation of Hara. That is, for the device of Hara to provide video conferencing as disclosed by Kamata would require serious modifications *e.g.*, a new program would have to be installed for video streaming. Because Hara seeks to reduce the cost of the device, it would be contrary to the purposes of Hara to include additional processors for streaming purposes from three or more sites. Alternatively, if only a single processor were to be maintained in Hara, it could not effectively handle streaming in a video conference due to the constant need to implement an interrupt from multiple sites (*see* Hara, ¶¶ 101 and 138).

For at least these exemplary reasons, claim 1 is patentable over Hara in view of Kamata. Accordingly, it is appropriate and necessary for the Examiner to withdraw this rejection of claim 1. Claims 2, 7-9, and 12 are patentable at least by virtue of their dependency on claim 1.

In addition, dependent claim 2 recites: “wherein the synthesized image data is obtained by cutting a portion of images representing the other image data and a portion of an image representing the first image data to match the size of a display displaying the synthesized image.”

The Examiner acknowledges that Hara does not disclose or suggest these unique features of claim 2. The Examiner, however, contends that Kamata cures the deficient disclosure of Hara. Specifically, in response to Applicant's arguments, the Examiner contends that reducing the size is the same as cutting the image as set forth in claim 2 (see page 4 of the Office Action). Applicant respectfully disagrees.

When the video size is reduced, a portion of the video is not cut *i.e.*, the entire video is still displayed but in a smaller size (col. 6, lines 14 to 19; col. 10, lines 13 to 34). That is, Kamata's disclosure of reducing the size, does not disclose or remotely suggest cutting a portion of the video stream. In other words, displaying entire video but in smaller size is not displaying only a portion of the video.

For at least these additional exemplary reasons, claim 2 is patentable over Hara in view of Kamata.

In addition, dependent claim 7 recites: "obtaining first user input designating a portion of the first image data that is to be kept; cutting the remaining of the first image based on the first user input; obtaining second user input designating a portion of the other image data that is to be kept; cutting the remaining other image data based on the second user input; and synthesizing the portion of first image and the portion of the second image into one single synthesized image based on third user input."

The Examiner acknowledges that Hara does not disclose or suggest the unique features of the dependent claim 7. The Examiner contends that Kamata in col. 6, lines 20 to 32 cure the above-identified deficiencies of Hara (see page 10 of the Office Action). Applicant respectfully disagrees.

Kamata in col. 6, lines 20 to 32 discloses “[a]n image selection and combination unit 24 is responsive to a signal for specifying how images are to be combined from a terminal that is to receive a composite image, i.e., an instruction to combine images in an arrangement that the user at that terminal desires, to select an output of the first image reduction and storage unit 21 and an output or outputs of one or more second image reduction and storage units 22 pixel by pixel, and combine the selected images in such a way that the speaker's image output from the first image reduction and storage unit 21 will occupy, for example, 75% of the area of the composite image, and other non-speakers' images will be arranged as specified by the instruction signal. The resulting composite image is then output to a composite image receiving terminal.”

As is visible from this quoted passage, Kamata only discloses reducing the entire image and not obtaining a portion of the entire image *i.e.*, cutting the image. For at least these additional exemplary reasons, claim 7 is patentable over Hirata in view of Kamata.

Next, independent claims 3 and 5 recite features similar to, although not necessarily coextensive with, the features argued above with respect to claim 1. Therefore, arguments presented with respect to claim 1 apply with equal force here. For at least substantially analogous exemplary reasons, therefore, independent claims 3 and 5 are patentable over Hara in view of Kamata. Claims 4 and 6 are patentable at least by virtue of their dependency on claims 3 and 5, respectively.

Claims 10 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hara and Kamata, in view of a newly found reference, U.S. Patent Publication No. 2006/0125927 to Watanabe (hereinafter “Watanabe2”), claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hara in view of another newly found reference, U.S. Patent Publication No.

2003/0140104 to Watanabe et al. (hereinafter “Watanabe”), claims 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hara and Watanabe in view of yet another newly found reference, U.S. Patent No. 6,519,048 to Tanaka (hereinafter “Tanaka”), and claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hara, Watanabe and Tanaka, in view of Watanabe2. Applicant respectfully traverses these grounds of rejection at least in view of the following exemplary comments.

Claims 10 and 11 depend on claim 1 and claims 16-19 dependent on claim 13. It was already demonstrated that Hara and Kamata do not meet all the requirements of independent claims 1 and 13. Watanabe, Watanabe 2, and Tanaka fail to cure the deficient teachings of Hara and Kamata. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claims 1 and 13. Since claims 10 and 11 depend on claim 1 and claims 16-19 depend on claim 13, they are patentable at least by virtue of their dependency.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Nataliya Dvorson/
Nataliya Dvorson
Registration No. 56,616

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: February 1, 2008